

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Stephen Paul Zadesky et al.

Serial No.: 10/643,256

Filing Date: August 18, 2003

For: MOVABLE TOUCH PAD WITH  
ADDED FUNCTIONALITY

Examiner: Jimmy H. Nguyen

Group Art Unit: 2629

Confirmation No.: 4668

**INFORMATION DISCLOSURE  
STATEMENT UNDER 37 C.F.R. § 1.97 & 1.98**

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Pursuant to 37 C.F.R. §1.97 and § 1.98, Applicants submit for consideration in the above-identified application the documents listed on the attached Form PTO/SB/08a/b. Copies of foreign documents and non-patent literature are submitted herewith. The Examiner is requested to make these documents of record.

Applicants submit herewith an Information Disclosure Statement identifying art of which applicant became aware as a result of the following Japanese patent proceedings:

(A) Civil Division 47th-B of Tokyo District Court

Complaint: Year 2007 (wa) No. 2525 Case of Demand for Declaratory Judgment of  
Non-indebtedness

Counterclaim: Year 2007 (wa) No. 6312 Case of Damages Counterclaim Plaintiff  
(Defendant in Counterclaim): Apple Japan, Inc.

Defendant (Plaintiff in Counterclaim): Shigeru Saito Architecture Research Institute  
Plaintiff (Defendant in Counterclaim) Intervenor: Apple Japan Holdings, Inc.

(B) Case No. 1000-1280

Details of Rights pertaining to Application for Import Suspension

- (1) Petitioner Shigeru Saito Architecture Research Institute
- (2) Name of product considered to be infringing Small, portable music player
- (3) Details of intellectual property

Patent rights pertaining to a contact operation-type input device and its electronic components Patent Number 3852854 [Claim 3]

The above-referenced Japanese patent proceedings involve alleged infringement by Apple Japan, Inc. of Japanese Patent JP 3852854. The above-referenced Japanese patent proceedings do not involve any patent corresponding to applicants subject U.S. patent application, for which allowance is now currently being sought.

This Information Disclosure Statement is submitted after receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance. A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.

Applicants would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.

The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petition and/or other

US Application No. 10/643,256

Atty. Docket No. 106842000600

fees due in connection with the filing of this document to **Deposit Account No. 03-1952**  
referencing (106842000600).

Dated: July 20, 2007

Respectfully submitted,

By   
Alex Chartove

Registration No.: 31,942  
MORRISON & FOERSTER LLP  
1650 Tysons Blvd, Suite 400  
McLean, Virginia 22102  
(703) 760-7744

Substitute for form 1449/PTO  <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  <i>(Use as many sheets as necessary)</i>				<b>Complete if Known</b>	
				Application Number	10/643,256
				Filing Date	August 18, 2003
				First Named Inventor	Stephen Paul Zadesky
				Art Unit	2629
				Examiner Name	Not yet assigned
Sheet	1	of	6	Attorney Docket Number	106842000600

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. <sup>1</sup>	Document Number Number-Kind Code <sup>2</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
	1.	1,061,578	05/13/1913	Wischhusen et al.	
	2.	2,903,229	02/24/1956	Landge	
	3.	2,798,907	07/09/1957	Schneider	
	4.	2,945,111	10/24/1958	McCormick	
	5.	3,965,399	06/22/1976	Walker et al.	
	6.	4,121,204	10/17/1978	Welch er al.	
	7.	4,129,747	12/12/1978	Pepper, J.	
	8.	4,242,676	12/30/1980	Piguet et al.	
	9.	4,246,452	01/20/1981	Chandler	
	10.	4,293,734	10/06/1981	Peper Jr.	
	11.	4,380,007	04/12/1983	Steinegger	
	12.	4,380,040	04/12/1983	Posset	
	13.	4,475,008	10/02/1984	Doi et al.	
	14.	4,570,149	02/11/1986	Thornburg et al.	
	15.	4,587,378	05/06/1986	Moore	
	16.	4,644,100	02/17/1987	Brenner et al.	
	17.	4,734,034	03/29/1988	Maness et al.	
	18.	4,736,191	04/05/1988	Matzke et al.	
	19.	4,739,299	04/19/1988	Eventoff et al.	
	20.	4,752,655	06/21/1988	Tajiri et al.	
	21.	4,755,765	07/05/1988	Ferland	
	22.	4,764,717	08/16/1988	Tucker et al.	
	23.	4,798,919	01/17/1989	Miessler et al.	
	24.	4,810,992	03/07/1989	Eventoff	
	25.	4,849,852	07/18/1989	Mullins	
	26.	4,856,993	08/15/1989	Maness et al.	
	27.	4,897,511	01/30/1990	Itaya et al.	
	28.	4,914,624	04/03/1990	Dunthorn	
	29.	5,008,497	04/16/1991	Asher	
	30.	5,036,321	07/30/1991	Leach et al.	
	31.	5,159,159	10/27/1992	Asher	
	32.	5,159,159	10/27/1992	Asher	

Examiner Signature		Date Considered	
-----------------------	--	--------------------	--

Substitute for form 1449/PTO  <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  <i>(Use as many sheets as necessary)</i>				<b>Complete if Known</b>	
				Application Number	10/643,256
				Filing Date	August 18, 2003
				First Named Inventor	Stephen Paul Zadesky
				Art Unit	2629
				Examiner Name	Not yet assigned
Sheet	2	of	6	Attorney Docket Number	106842000600

	33.	5,231,326	07/27/1993	Echols	
	34.	5,305,017	04/19/1994	Gerpheide	
	35.	5,367,199	11/22/1994	Lefkowitz et al.	
	36.	5,416,498	05/16/1995	Grant	
	37.	5,424,756	06/13/1995	Ho et al.	
	38.	5,432,531	07/11/1995	Calder et al.	
	39.	5,450,075	09/12/1995	Waddington	
	40.	5,479,192	12/26/1995	Carroll, Jr. et al.	
	41.	5,559,301	09/24/1996	Bryan Jr. et al.	
	42.	5,581,670	12/03/1996	Bler et al.	
	43.	5,589,893	12/31/1996	Gaughan et al.	
	44.	5,613,137	03/18/1997	Bertram et al.	
	45.	5,617,114	04/01/1997	Bier et al.	
	46.	5,632,679	05/27/1997	Tremmel	
	47.	5,627,531	08/06/1997	Posso et al.	
	48.	5,657,012	08/12/1997	Tart	
	49.	5,689,285	11/18/1997	Asher	
	50.	5,790,769	08/04/1998	Buxton et al.	
	51.	5,805,144	09/08/1998	Scholder et al.	
	52.	5,841,423	11/24/1998	Carroll Jr. et al.	
	53.	5,859,629	01/12/1999	Tognazzini	
	54.	5,875,311	02/23/1999	Bertram et al.	
	55.	5,903,229	05/11/1999	Kishi	
	56.	5,943,044	08/24/1999	Martinelli et al.	
	57.	6,034,672	03/07/2000	Gaultiet et al.	
	58.	6,057,829	08/02/2000	Silfvast	
	59.	6,473,069	10/29/2002	Gerphelde	
	60.	6,492,979	12/10/2002	Kent et al.	
	61.	6,496,181	12/17/2002	Bomer et al.	
	62.	2004-0267874	12/30/2004	Westberg et al.	
	63.	6,894,916	5/17/2005	Reohr et al.	
	64.	2007/0080936	4/12/2007	Tsuk et al.	
	65.	2007/0080938	4/12/2007	Robbin et al.	
	66.	2007/0085841	4/19/2007	Tsuk et al.	

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

Substitute for form 1449/PTO  <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  <i>(Use as many sheets as necessary)</i>				<b>Complete if Known</b>	
				Application Number	10/643,256
				Filing Date	August 18, 2003
				First Named Inventor	Stephen Paul Zadesky
				Art Unit	2629
				Examiner Name	Not yet assigned
Sheet	3	of	6	Attorney Docket Number	106842000600

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
		Country Code <sup>3</sup> -Number <sup>4</sup> -Kind Code <sup>5</sup> (if known)				
	67.	JU 57-95722	06/12/1982			
	68.	JU 55-174009	06/17/1982			
	69.	JP 61-164547	01/28/1988			
	70.	JP 63-298518	12/06/1988			
	71.	JU 03-57617	06/04/1991			
	72.	JP 04-32920	02/04/1992			
	73.	JU 05-36623	05/18/1993			
	74.	FR 2 686 440 A1	07/23/1993			
	75.	JP 05-233141	09/10/1993			
	76.	JP 05-262276	10/12/1993			
	77.	JP 05-289811	11/05/1993			
	78.	JP 06-20570	01/28/1994			
	79.	JP 06-096639	04/08/1994			
	80.	JP 06-111685	04/22/1994			
	81.	JP 06-187078	07/08/1994			
	82.	JP 06-208433	07/26/1994			
	83.	JP 06-283993	10/07/1994			
	84.	WO 95/00897-A1	01/05/1995			
	85.	JP 07-107574	04/21/1995			
	86.	JU 07-41882	07/21/1995			
	87.	JP 07-201256	08/04/1995			
	88.	EP 0674288 A1	09/27/1995			
	89.	JP 07-253838	10/03/1995			
	90.	JP 07-261899	10/13/1995			
	91.	JP 07-296670	11/10/1995			

Examiner Signature		Date Considered	
-----------------------	--	--------------------	--

Substitute for form 1449/PTO  <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  <i>(Use as many sheets as necessary)</i>				<b>Complete if Known</b>	
				Application Number	10/643,256
				Filing Date	August 18, 2003
				First Named Inventor	Stephen Paul Zadesky
				Art Unit	2629
				Examiner Name	Not yet assigned
Sheet	4	of	6	Attorney Docket Number	106842000600

	92.	JP 08-016292	01/19/1996			
	93.	JP 08-115158	05/07/1996			
	94.	EP 0 731 407 A1	09/11/1996			
	95.	JP 08-299541	11/19/1996			
	96.	EP 0 551 778 B1	01/15/1997			
	97.	JP 09-128148	05/16/1997			
	98.	JP 09-230993	09/05/1997			
	99.	JP 09-233161	09/05/1997			
	100.	JP 10-074429	03/17/1998			
	101.	JP 10-227878	08/25/1998			
	102.	JP 11-184607	07/09/1999			
	103.	JPA 10-012010	07/21/1999			
	104.	JPA 10-012025	07/21/1999			
	105.	JPA 10-012026	07/21/1999			
	106.	JPA 10-012027	07/21/1999			
	107.	JPA 10-012028	07/21/1999			
	108.	JPA 10-012029	07/21/1999			
	109.	JP 11-203045	07/30/1999			
	110.	JPA 10-089535	10/08/1999			
	111.	JP 2000-267786	09/29/2000			
	112.	JP 2001-11769	01/16/2001			
	113.	JP 2001-22508	01/26/2001			
	114.	JP 2002-215311	08/02/2002			
	115.	JPA 2005-99635	09/15/2005			
	116.	JPA 2005-133824	10/13/2005			
	117.	JPA 2005-134953	10/20/2005			
	118.	JPA 2005-235579	01/05/2006			

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

Substitute for form 1449/PTO  <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  <i>(Use as many sheets as necessary)</i>				<b>Complete if Known</b>	
				Application Number	10/643,256
				Filing Date	August 18, 2003
				First Named Inventor	Stephen Paul Zadesky
				Art Unit	2629
				Examiner Name	Not yet assigned
Sheet	5	of	6	Attorney Docket Number	106842000600

119.	JPA 2005-358970	07/06/2006			
120.	JP-3,852,854	09/15/2006			
121.	JPA 2005-312433	05/17/2007			

\*EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS				
Examiner Initials	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>	
	122.	"Atari VCS/2600 Peripherals", <a href="http://www.classicgaming.com">www.classicgaming.com</a> , downloaded February 28, 2007, pp. 1-15.		
	123.	"Alps Electric introduces the GlidePoint Wave Keyboard; combines a gently curved design with Alps' advanced GlidePoint Technology", Business Wire, (October 21, 1996).		
	124.	"Alps Electric Ships GlidePoint Keyboard for the Macintosh; Includes a GlidePoint Touchpad, Erase-Eaze Backspace Key and Contoured Wrist Rest, Business Wire, (July 1, 1996)		
	125.	"APS show guide to exhibitors", Physics Today, 49(3) (March 1996).		
	126.	"Design News literature plus", Design News, 51(24) (December 18, 1995).		
	127.	"Manufactures", Laser Focus World, Buyers Guide '96, 31(12) (December 1995).		
	128.	"National Design Engineering Show", Design News, 52(5) (March 4, 1996).		
	129.	"Preview of exhibitor booths at the Philadelphia show", Air Conditioning Heating & Refrigerator News, 200(2) (January 13, 1997).		
	130.	"Product news", Design News, 53(11) (June 9, 1997).		
	131.	"Product news", Design News, 53(9) (May 5, 1997).		
	132.	Ahl, David, "Controller Updated", Creative Computing 9(12) (December 1983).		
	133.	Baig, E.C., "Your PC Might Just Need a Mouse", U.S. News and World Report, 108(22), (June 4, 1990)		
	134.	Bartimo, Jim, "The Portables: Traveling Quickly", Computerworld (November 14, 1983).		
	135.	Brink et al., "Pumped-up portables", U.S. News & World Report, 116(21) (May 30, 1994).		
	136.	Brown et al., "Windows on Tablets as a Means of Achieving Virtual Input Devices", Human-Computer Interaction - INTERACT '90 (1990).		
	137.	Buxton et al., "Issues and Techniques in Touch-Sensitive Tablet Input", Computer Graphics, 19(3), Proceedings of SIGGRAPH '85 (1985).		
	138.	Chen et al., "A Study in Interactive 3-D Rotation Using 2-D Control Devices", Computer Graphics 22(4) (August 1988).		
	139.	Evans et al., "Tablet-based Valuator that Provide One, Two, or Three Degrees of Freedom", Computer Graphics 15(3) (August 1981).		

Examiner Signature		Date Considered	
--------------------	--	-----------------	--



Substitute for form 1449/PTO  <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  <i>(Use as many sheets as necessary)</i>				<b>Complete if Known</b>	
				Application Number	10/643,256
				Filing Date	August 18, 2003
				First Named Inventor	Stephen Paul Zadesky
				Art Unit	2629
				Examiner Name	Not yet assigned
Sheet	6	of	6	Attorney Docket Number	106842000600

	140.	Jesitus, John , "Broken promises?", Industry Week/IW, 246(20) (November 3, 1997).	
	141.	Mims, Forrest M. III, "A Few Quick Pointers; Mouses, Touch Screens, Touch Pads, Light Pads, and the Like Can Make Your System Easier to Use", Computers and Electronics, 22, (May, 1984)	
	142.	Nass, Richard, "Touchpad input device goes digital to give portable systems a desktop "mouse-like" feel", Electronic Design, 44(18) (September 3, 1996).	
	143.	Perenson, Melissa, "New & Improved: Touchpad Redux", PC Magazine (September 10, 1996).	
	144.	Petersen, Marty, "Koalapad Touch Tablet & Micro Illustrator Software", InfoWorld, (October 10, 1983)	
	145.	Petruzzellis, "Force-Sensing Resistors" Electronics Now, 64(3), (March 1993).	
	146.	Soderholm, Lars D., "Sensing Systems for 'Touch and Feel'", Design News, (May 8, 1989)	
	147.	Sony presents "Choice Without Compromise" at IBC '97 M2 PRESSWIRE (July 24, 1997.)	
	148.	Spiwak, Marc, "A Great New Wireless Keyboard", Popular Electronics, 14(12) (December 1997).	
	149.	Spiwak, Marc, "A Pair of Unusual Controllers", Popular Electronics 14(4) (April 1997).	
	150.	Tessler, Franklin, "Point Pad", Macworld 12(10) (October 1995).	
	151.	Tessler, Franklin, "Smart Input: How to Chose from the New Generation of Innovative Input Devices," Macworld 13(5) (May 1996).	
	152.	Tessler, Franklin, "Touchpads", Macworld 13(2) (February 1996).	
	153.	"Triax Custom Controllers Due; Video Game Controllers," HFD-The Weekly Home Furnishings Newspaper, 67(1), (January 4, 1993)	

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup>Applicant's unique citation designation number (optional). <sup>2</sup>Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature		Date Considered	
--------------------	--	-----------------	--